



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/623,756 | 09/08/2000 | Yoshiyuki Hiraga | 20-4746P | 6683 |

2292 7590 12/10/2002

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

WILSON, DONALD R

ART UNIT PAPER NUMBER

1713

9

DATE MAILED: 12/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/623,756

Applicant(s)

HIRAGA ET AL.

Examiner

D. R. Wilson

Art Unit

1713

AC-9

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6 and 12-17 is/are pending in the application.
- 4a) Of the above claim(s) 7-10 and 12-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1713

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed 11/4/02, has been fully considered with the following results.
2. The amendment is not deemed to be persuasive in overcoming the prior art rejections over Schreyer, Bailey, Roura, or Carlson as evidenced by Bro, and the rejections over these references are maintained for reasons discussed below.
3. The amendment is deemed persuasive in overcoming the rejection based upon Goldman and the rejection is withdrawn. Although Goldman exemplifies the complete removal of -COF end groups, and molded polymer containing no bubbles, there does not appear to be a basis for concluding that the combination of spin densities and volatile index is inherent or obvious in the treatment methods disclosed.

Previously Cited Statutes

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102(b)/§ 103(a)

5. **Claims 1-2, 4 and 6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schreyer, Bailey or Roura.** The basis of this rejection was stated in Detailed Action § 6-9 of the previous Office Action.

6. Applicant traverses the rejection over Schreyer stating that "--- the treated copolymers as disclosed in Schreyer '083 have a volatile index that is much larger than 25", and that "[n]othing in Schreyer '083 suggests accomplishing the claimed volatile index range." This is not deemed to be persuasive because applicant has ignored the specific teachings in Example V, as shown in Table IV wherein volatile indexes of 20 to 25 are shown for treated samples. Applicants further note that Schreyer does not disclose kneading as recited in Claim 4. This is not deemed to be persuasive because kneading is a product-by-process limitation and it is not seen that applicant has shown that the product obtained is substantially different as a result of kneading during the moisture treating step. As has been previously pointed out -

When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim it is appropriate for the examiner to make a rejection under both the applicable section of 35 USC 102 and 35 USC 103 such that the burden is placed upon applicant to provide clear and convincing factual evidence that the respective products do in fact differ in kind - *In re Brown*, 59 CCPA 1063, 173 USPQ 685 (1972); *In re Fessman*, 180 USPQ 324 (CCPA 1974) - and to come forward with evidence establishing unobvious differences between the claimed product and the prior art product. *In re Marosi* 218 USPQ 290.

7. Applicant traverses the rejection over both Bailey and Roura on the basis that neither reference discloses "--- the use of any base such as a compound comprising an alkali metal or an alkaline metal (sic)". This is not deemed to be persuasive because it is not seen that any of the claims require the presence of a base such as a compound comprising an alkali metal or an alkaline earth metal. Further, applicant is again reminded that it is the product being claimed, not the process. For reasons of record, the burden is on applicant to show that the stabilized product of Bailey and Roura are different than those of the instant claims.

8. **Claims 1-2, 4 and 6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Carlson as evidenced by Bro.** The basis of this rejection was stated in Detailed Action § 11-12 of the previous Office Action.

9. Applicant traverses the rejection with the argument that "--- the copolymers in Carlson '758 are not molten" (presumably meaning the treatment is not done under molten conditions), and concludes that "[t]hus, neither unstable terminal groups nor unstable bonds would be removed in order to achieve a volatile index decrease to 25 or less." This is not deemed to be persuasive because it is not supported by any evidence. Further, Examples VI and VII, provide evidence of complete removal of carboxylic acid end groups from TFE/HFP copolymers. Additionally, treatments of other fluoropolymers under the methods disclosed exemplify volatile indices of less than 25 (Examples I, II and V). There is simply no basis for concluding that the polymers must be molten during treatment to adequately remove unstable groups.

Art of Interest/Technological Background

10. The prior art of record and not relied upon is considered pertinent to applicant's disclosure. WO'784 discloses TFE/HFP copolymers with spin densities and volatile indices within the limits of the

Art Unit: 1713

instant claims and has a publication date of 3/12/98. A rejection is not being made at this time as the outstanding rejections are still believed valid. Applicant cannot rely upon the foreign priority papers to overcome a future rejection over WO'748 because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15. Hiraga'146 is based on the PCT from which WO'748 is derived.

Action Is Final

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

12. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

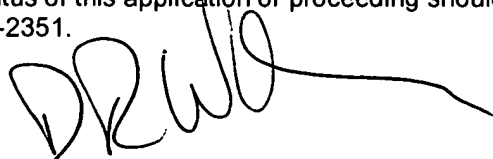
13. This application contains claims 7-10 and 12-17 drawn to an invention nonelected with traverse in Paper No. 6. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. R. Wilson whose telephone number is 703-308-2398.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 703-308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications. The unofficial direct fax phone number to the Examiner's desk is 703-872-9029.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.

A handwritten signature in black ink, appearing to read 'DR Wilson', with a long horizontal line extending to the right.

D. R. Wilson
Primary Examiner
Art Unit 1713